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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,112	10/30/2000	Michael Gottlieb Jensen	1778.1730000	8333

26111 7590 10/05/2005

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EXAMINER	
ELLIS, RICHARD L	

ART UNIT	PAPER NUMBER
2183	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/702,112	JENSEN ET AL.	
	Examiner	Art Unit	
	Richard Ellis	2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,9,18,36-41,43-48,58-62 and 68-83* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1,9,18,36-41,43-48 and 58-62* is/are allowed.

6)☒ Claim(s) *68-83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20050722*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1, 9, 18, 36-41, 43-48, 58-62 are presented for examination. Claims 68-83 are newly presented for examination.

2. Claims 1, 9, 18, 36-41, 43-48, 58-62 are allowable over the prior art of record.

3. The information disclosure statement ("IDS") filed July 22, 2005 fails to fully comply with 37 CFR 1.98(b)(4) which states:

> (4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the ***country or patent office*** which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

Applicant is reminded that "Europe" is a continent, not a country, and as such does not meet the requirements for "country or patent office" which issued the patent or published the application. The correct designation for European Patent Office documents is "EPO".

Applicant's IDS fails to meet the requirements of 37 CFR 1.98(b)(4) by listing four documents with the incorrect designation "Europe".

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 9, 18, 36-41, 43-48, 58-62, and 68-83 of the present patent application contain every element of claims 1-32 of copending application 09/702,115 and as such anticipate those claims of the copending application.

> "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type doublepatenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus." *Eli Lilly and Company v. Barr Laboratories, Inc.*, United States Court of Appeals for the Federal Circuit, on petition for rehearing en banc (Decided: May 30, 2001).

6. The following is a quotation of 35 USC § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. This application currently names joint inventors. In considering patentability of the claims under 35 USC § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 USC § 102(f) or (g) prior art under 35 USC § 103.

8. New claims 68-83 are rejected under 35 USC § 103 as being unpatentable over Larsen et al., U.S. patent 5,115,500, in view of Heene et al., U.S. Patent 4,802,119.

Larsen et al. and Heene et al. were first cited as prior art references in paper number 6, mailed November 14, 2003.

9. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number 20050418, mailed April 22, 2005.

10. As to new claims 68-75 and 83, they correspond word for word with claims 1, 9, 36-41 and 58 as those claims stood in the last office action, with the exception of the addition of the term "in parallel" modifying the term "comparing". The previously presented rejection of claims 1, 9, 36-41 and 58 is hereby incorporated by reference to the last office action as reading upon new claims 68-75 and 83. As to the newly added "in parallel" language, as is

clearly seen from the Heene et al. reference in fig. 4 (which also happens to be the front page drawing) an address for comparison appears on bus 12, and is compared to addresses in boundary registers 51, 56, 61, and 66 by comparators 50, 55, 60, and 65. As seen from fig. 4, comparators 50, 55, 60, and 65 are connected to bus 12 **in parallel** and therefore, the structure disclosed by Heene et al. is "comparing, in parallel, the address to boundary addresses" as claimed by the new claims. The correspondence of the claims is as follows:

Old Claim	New Claim	Old Claim	New Claim
1	68	39	73
9	69	40	74
36	70	41	75
37	71	58	83
38	72		

11. As to new claims 76-82, they correspond word for word with claims 18, and 43-48 as those claims stood in the last office action, with the exception of the addition of the term "in parallel" modifying the term "compares" and "that partition an address space of the processor into a plurality of address ranges" modifying the term "boundary address registers". The previously presented rejection of claims 18 and 43-48 is hereby incorporated by reference to the last office action as reading upon new claims 76-82. As to the newly added "in parallel" language, see the discussion in the previous paragraph. As to the newly added "partition ..." language, as seen from fig. 2 of the Larsen reference, the purpose of Larsen's system is to partition (line between Type 1 and Type 2 ranges) an address range (I-Store) into a plurality of address ranges (Type 1, Type 2). The correspondence of the claims is as follows:

Old Claim	New Claim	Old Claim	New Claim
18	76	46	80
43	77	47	81
44	78	48	82
45	79		

12. Applicant's arguments in favor of new claims 68-83 consist of a single argument that the address comparison is accomplished in parallel. This aspect has been addressed above.

13. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 USC 133, MPEP 710.02, 710.02(b)).

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (571) 272-4165. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (571) 272-4162. The fax phone number for the USPTO is: (703)872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Richard Ellis
September 26, 2005

RICHARD L. ELLIS
PRIMARY EXAMINER